




UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,553	01/25/2000	Jeffrey A. Morgan	10992213-1	7289
22879	7590	12/14/2004	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			LIN, KENNY S	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/490,553	Applicant(s) MORGAN ET AL. 	
	Examiner Kenny Lin	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-34 are presented for examination. Claim 35 is canceled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4, 7-11, 13, 15-20, 22-24, 29, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cardillo, IV et al (hereinafter Cardillo), U.S. Patent 5,937,041, in view of Perlman et al (hereinafter Perlman), US 6,308,221.

4. Cardillo and Perlman were cited in the previous office action.

5. As per claim 1, Cardillo taught the invention substantially as claimed including a system for providing Internet-related services in response to a handheld device without requiring the handheld device to itself be Internet-enabled, (col.1, lines 28-32, col.5, lines 47-67), comprising:

- a. A client module (ADSI, col.1, lines 28-52) embedded in the handheld device (col.1, lines 28-32, col.2, lines 28-31, col.6, line 24) to enable the handheld device to send a selected stored URL via a local communication link, wherein the URL

Art Unit: 2154

indicates a desired Internet web page (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, 65-67, col.8, lines 1-3; the request can be a URL for retrieving a web page);

- b. A receiver that receives the URL sent from the handheld device via the local communication link (col.6, lines 1-10, 17-19, 45-47, col.7, lines 1-12);
- c. A web access module coupled to the receiver and to an external Internet via an Internet communication link different from said local communication link to access and retrieve the desired web page from a remote web server via the external Internet (col.2, lines 32-36, col.6, lines 4-10; web access module such as modem or Ethernet card is required and necessary in order for a device to connect and communicate with a Internet based server).

6. Cardillo did not specifically teach a render system being coupled to the web access module and physically separated from said handheld device, to render the retrieved web page in a human discernible format to a user on said render system. Perlman taught a render system being coupled to the web access module and physically separated from said handheld device (col.4, lines 26-38, 46-48), to render the retrieved web page in a human discernible format to a user on said render system (col.1, lines 43-45, col.4, lines 26-38, 55-65, col.8, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and Perlman because Perlman's teaching of using a render system separated from handheld device to display web pages enables Cardillo's system to

Art Unit: 2154

browse and display web pages on a television set using a remote controller (see Perlman, col.1, lines 41-48).

7. As per claim 13, Cardillo taught the invention substantially as claimed including a system for providing an Internet-related service from a remote Internet-related server via an Internet communication link based on a URL indicated by a handheld device (col.1, lines 28-32, col.5, lines 47-67), comprising:

- a. A receiver module to receive the URL from the handheld device via a local communication link (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, 65-67, col.8, lines 1-3; the request can be a URL for retrieving a web page);
- b. A web access module to access and retrieve the Internet-related service via the Internet communication link based on the URL (col.2, lines 32-36, col.6, lines 4-10; web access module such as modem or Ethernet card is required and necessary in order for a device to connect and communicate with a Internet based server).

8. Cardillo did not specifically teach a render module, coupled to the web access module and physically separated from the handheld device, to render the retrieved Internet-related service in a human discernible format to a user on the render module. Perlman taught a render module coupled to the web access module and physically separated from the handheld device (col.4, lines 26-38, 46-48), to render the retrieved Internet-related service in a human discernible format to a user on said render module (col.1, lines 43-45, col.4, lines 26-38, 55-65, col.8, lines

Art Unit: 2154

5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and Perlman because Perlman's teaching of using a render module separated from handheld device to access and display Internet-related services enables Cardillo's system to access and display email on a television set using a remote controller (see Perlman, col.1, lines 41-48).

9. As per claim 29, Cardillo taught the invention substantially as claimed including a mobile system capable of communicating with a gateway module, which comprise a web access module to access and retrieve an Internet-related service from a remote Internet-related server via an Internet communication link based on a URL (col.2, lines 32-36, 41-46, col.5, lines 61-64, col.6, lines 4-10; web access module such as modem or Ethernet card is required and necessary in order for a device to connect and communicate with a Internet based server), the mobile system comprising:

- a. A client module (ADSI, col.1, lines 28-52) to enable sending the URL via a communication link to the gateway module for use in the access and retrieval of the Internet-related service (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, 65-67, col.8, lines 1-3; the request can be a URL for retrieving a web page).

10. Cardillo did not specifically teach a render module to receive the retrieved Internet-related service, wherein the gateway module communicates the retrieved Internet-related service with the rendering module, which is physically separated from the mobile system, and is

Art Unit: 2154

configured to render the retrieved Internet-related service in a human discernible format to a user on the rendering module. Perlman taught a render module to receive the retrieved Internet-related service wherein the gateway module communicates the retrieved Internet-related service with the rendering module (col.4, lines 26-38, 55-65, col.8, lines 5-14), which is physically separated from the mobile system (col.4, lines 26-38, 46-48), and is configured to render the retrieved Internet-related service in a human discernible format to a user on the rendering module (col.1, lines 43-45, col.4, lines 26-38, 55-65, col.8, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and Perlman because Perlman's teaching of using a render module separated from mobile device to access and display Internet-related services enables Cardillo's system to access and display email on a television set using a remote controller (see Perlman, col.1, lines 41-48).

11. As per claim 32, Cardillo taught the invention substantially as claimed including a gateway system capable of receiving a communication including URL via a communication link from a mobile system (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, 65-67, col.8, lines 1-3; the request can be a URL for retrieving a web page), said gateway system comprising:

- a. A communication module to receive the communication from mobile system, said communication including a selected URL (col.6, lines 1-27, 45-47, col.7, lines 1-12, 65-67, col.8, lines 1-3);
- b. A web access module to access and retrieve an Internet-related service from a remote Internet-related server via an Internet communication link based on the

Art Unit: 2154

URL (col.2, lines 32-36, col.6, lines 4-10; web access module such as modem or Ethernet card is required and necessary in order for a device to connect and communicate with a Internet based server).

12. Cardillo did not specifically teach a render module to receive the retrieved Internet-related service from the web access module, said render module being physically separated from said mobile system and configured to render the retrieved Internet-related service in a human discernible format to a user on the render module. Perlman taught a render module to receive the retrieved Internet-related service from the web access module (col.4, lines 26-38, 55-65, col.8, lines 5-14), said render module being physically separated from said mobile system (col.4, lines 26-38, 46-48) and configured to render the retrieved Internet-related service in a human discernible format to a user on the render module (col.1, lines 43-45, col.4, lines 26-38, 55-65, col.8, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and Perlman because Perlman's teaching of using a render module separated from mobile system to access and display Internet-related services enables Cardillo's system to access and display email on a television set using a remote controller (see Perlman, col.1, lines 41-48).

13. As per claim 2, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught that the handheld device fits into a user's palm (palm PDA, col.1, lines 28-32, col.2, lines 28-31).

Art Unit: 2154

14. As per claims 4 and 33, Cardillo and Perlman taught the invention substantially as claimed in claims 1 and 32. Cardillo further taught a communication module in the handheld device that receives the URL from a remote site via a second communication link coupled to the communication module (col.6, lines 24-36, col.7, lines 65-67, col.8, lines 1-3; data received from the NAV can include URL).

15. As per claims 7 and 34, Cardillo and Perlman taught the invention substantially as claimed in claims 1 and 33. Perlman further taught that the receiver, the web access module, and the render system all physically reside within a single enclosure separate from the handheld device (col.4, lines 26-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings of Cardillo and Perlman and to build the receiver, the web access module and the render system in Cardillo's system within a single enclosure separate from the handheld device as a single unit to save space.

16. As per claims 8-9 and 17-18, Cardillo and Perlman taught the invention substantially as claimed in claims 1 and 13. Perlman further taught that the local communication link is a wireless communication link and is selected from a group of communication links consisting of: an infrared communication link or other equivalent modes (col.4, lines 46-52). Cardillo and Perlman did not specifically teach that the wireless communication link is selected from a group of communication links consisting of: a radio frequency communication link, a microwave communication link, a laser communication link, and combination thereof. However, it would have been obvious for one of ordinary skill in the art to implement different types or

Art Unit: 2154

combinations of these listed communication links as the wireless communication link.

Furthermore, one of ordinary skill in the art would have been motivated to select types of wireless communication links according to the users' needs or cost of implementation to provide better mobility. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and Perlman because Perlman's teaching of using various types or the combination of wireless communication link eliminates the needs for using physical cables and fully advance the mobility of Cardillo's handheld devices.

17. As per claims 10-11 and 15-16, Cardillo and Perlman taught the invention substantially as claimed in claims 1 and 13. Cardillo further taught that the web access module communicates with the remote web server via the Internet communication link using an open standard communication protocol such as HTTP (col.3, lines 4-16, col.7, lines 1-12).

18. As per claim 19, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught wherein the web access module comprises a web browser without a rendering function (col.6, lines 4-16, col.7, lines 1-26).

19. As per claim 20, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught that the rendering system is a device-specific rendering system (col.4, lines 37-41, col.7, lines 13-18, 28-43).

Art Unit: 2154

20. As per claim 22, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught that the handheld device is a pager (col.1, lines 28-32, col.2, lines 28-31).

21. As per claims 23, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught that the client module does not have Internet access function and does not include an Internet web browser application program or provide any direct connectivity to the Internet (col.4, lines 46-57, col.5, lines 50-57, fig.2).

22. As per claims 24, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught that the client module has Internet access function and include an Internet web browser, but neither the Internet access function nor the Internet web browser are utilized to send the URL via the local communication link (col.2, lines 24-47).

23. As per claims 31, Cardillo and Perlman taught the invention substantially as claimed in claim 30. Cardillo further taught a communication module in the handheld device that receives the URL from a remote site via a second communication link coupled to the communication module (col.6, lines 24-27, it is inherently known that data received from the data center can include URL).

Art Unit: 2154

24. Claims 3, 5-6, 12, 14, 21, 25-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cardillo and Perlman as applied to claims 1, 4, 13 and 29 above, and further in view of "Official Notice".

25. As per claims 3 and 30, Cardillo and Perlman taught the invention substantially as claimed in claims 1 and 29. Cardillo further taught that the client device can store data (col.6, lines 24-27). Cardillo and Perlman did not specifically teach to further comprising a memory coupled with the handheld device to store at least one URL, wherein the URL sent is selected from the at least one URL. However, it is well known in the art that many handheld devices contain memory to store data. For example, memory are provided in cell phones to store phone and contact information. Official Notice is taken that it would have been obvious to store data such as URL in a handheld device to bookmark web pages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo, Perlman and further provide memory to the handheld device to store URL for user to bookmark desired web pages.

26. As per claim 5, Cardillo and Perlman taught the invention substantially as claimed in claim 4. Cardillo and Perlman did not specifically teach that the second communication link is a link to a wireless network. However, Official Notice is taken that it would have been obvious to use link to a wireless network for portable devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the second communication

Art Unit: 2154

link linking to a wireless network in Cardillo and Perlman's system to provide wireless communication for portable device and reduce the need of physical connection.

27. As per claims 6 and 21, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo further taught that the handheld device is selected from a group of devices consisting of: a pager device, a cellular phone device, a personal organizer device, and a palm pilot device (col.1, lines 28-32, col.2, lines 24-31). Cardillo and Perlman did not specifically teach that the handheld device consisting of a watch device and an information appliance device. However, many different portable devices can be selected and used in Cardillo and Perlman's system. It would have been a design choice to pick and select all suitable handheld devices usable in the taught invention. Official Notice is taken that the limitations narrowed by these claims are consider obvious and furthermore a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select any suitable handheld devices as the handheld device taught by Cardillo and Perlman so to enable users of different types of handheld devices to have the ability to access and communicate with the web access module taught in Cardillo and Perlman's system and retrieve web page contents.

28. As per claims 12, 14 and 27-28, Cardillo and Perlman taught the invention substantially as claimed in claims 1 and 13. Perlman further taught did not specifically teach that the render system further comprises at least one render system selected from a group of systems consisting of: a display system, a user interface display system, an audio/video player system, a Web

Art Unit: 2154

television system, and a combination thereof (col.4, lines 26-38, 55-65, col.8, lines 5-14).

Cardillo and Perlman did not specifically teach that the render system further comprises at least one render system selected from a group of systems consisting of: a printer system, a display system, a projection display system, a user interface display system, an audio/video player system, a Web television system, and a combination thereof. However, Official Notice is taken that the limitations narrowed by these claims are consider obvious and furthermore a matter of design choice. It would have been obvious to select different types or combinations of outputting systems as the rendering system according to different needs. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo, Perlman and a use of outputting systems of any type or combination of types as the rendering system to display or print the desired contents to provide the users' different needs (i.e. presentations, reports).

29. As per claim 25, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo and Perlman did not specifically teach wherein only the URL is communicated, and the URL is communicated by sending only a few bytes of data. However, Official Notice is taken that it would have been obvious that URL can be communicated by sending only a few bytes of data since URLs are relatively small in size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to communicate the URL by sending only a few bytes of data since URL is known to be small in size for transmission.

Art Unit: 2154

30. As per claim 26, Cardillo and Perlman taught the invention substantially as claimed in claim 1. Cardillo and Perlman did not specifically teach that the URL is in the actual URL form or embedded in a hyperlink. However, Official Notice is taken that it would have been obvious to one of ordinary skill in the art to recognize that the URL is in the actual form or embedded in a hyperlink since they are the most common formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide URL in the actual URL form or embedded in a hyperlink to Cardillo and Perlman's system since they are widely used in the art.

Response to Arguments

31. Applicant's arguments filed 8/16/2004 have been fully considered but they are not persuasive.

32. In the remark, applicant argued (1) Cardillo does not disclose or suggest the client module because (i) the handheld device does not have a client module to enable the handheld device to send a URL (ii) The ADSI protocol transmission signals are Dual Tone Multi Frequency signals which is not URL. (2) Perlman does not disclose or suggest the client module because (i) Perlman sends infrared commands via an infrared communication link and does not have the capability of sending a selected URL (ii) Perlman also did not disclose or suggest the client module.

33. Examiner traverse the arguments

Art Unit: 2154

As to point (1), Cardillo clearly taught the handheld device (including television, PDA, pagers, PC, col.1, lines 28-32, col.2, lines 28-31) to be an ADSI enabled device (e.g. ADSI capability client module in supporting users to select stored features; col.1, lines 7-10, 20-27, 46-52, col.6, line 24). Cardillo taught that the ADSI protocol transmission signals **may be** Dual Tone Multi Frequency signals, Cardillo further mentioned that the transmission signals **are not limited to** DTMF (see, col.6, lines 36-38; transmission signals may include, but are not limited to, DTMF signals...). It would have been obvious to transmit URL using other signals available (e.g., said signals that transmit the URL and does not need to be converted by the NAV). Furthermore, Cardillo taught to select one of the available URLs from the screen of the handheld device (col.7, lines 55-67, col.8, lines 1-3) using a softkey. Hence, Cardillo reference does teach the client module enabling the handheld device to send a stored URL.

As to point (2), Perlman taught to use infrared to transmit *commands*. Perlman did not specifically teach a client module and to send selected URL. However, such deficits were overcome by Cardillo reference. Hence the combination of Cardillo and Perlman teaches and suggests the limitations claimed in the currently pending claims.

34. Because Applicants have failed to challenge any of the Examiner's "Official Notices" stated in the previous office action in a proper and reasonably manner, they are now considered as admitted prior art. See MPEP 2144.03

Conclusion

Art Unit: 2154

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
December 10, 2004

Allen Jan L.
12/9/04.